

PATENTS

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

Oswaldo da Costa e Silva et al.

Serial No. 09/828,447

Filed: **April 6, 2001**

For: **Signal Transduction Stress-Related
Proteins and Methods of Use in
Plants**

Art Unit: 1638

Examiner: **Cynthia E. Collins**

**COPY OF PAPERS
ORIGINALLY FILED**

RESPONSE TO RESTRICTION REQUIREMENT

Commissioner for Patents
Washington, DC 20231

Sir:

Responsive to the Office Communication mailed April 30, 2002, Applicants provisionally elect with traverse Claim Group I which encompasses claims 1-11 and 15-23, drawn to a transgenic plant cell, a seed, an isolated STSRP coding nucleic acid, a recombinant expression vector, and a method of producing a transgenic plant. Applicants further elect with traverse Group B which encompasses the PLC-2 protein and nucleic acid pair (SEQ ID NOS:12 and 7). The restriction requirement between the five groups of claims (A, B, C, D, and E) is respectfully traversed on the basis that the examination of the five groups of claims would not be an undue burden because of their close technological relationship.

I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail in an envelope addressed to: Commissioner for Patents, Washington, DC 20231, on June 28, 2002.

William L. Warren, Reg. No. 36.714

In order for a restriction requirement to be appropriate, there must be a serious burden on the Examiner to search all of the inventions and the inventions must be independent or distinct as claimed. The Examiner has not provided evidence that a search of all the STSRP proteins and nucleic acids would be seriously burdensome. The fact that all of these STSRP coding nucleic acids are listed as a Markush group in Claims 15 and 16 shows that a search and examination of all five STSRP coding nucleic acids would not present a serious burden. When the allegedly distinct inventions are presented in a Markush group, Section 803.02 of the MPEP states that "if the members of the Markush group are sufficiently few in number or so closely related that a search and examination of the entire claim can be made without serious burden, the Examiner must examine all the members of the Markush group in the claims on the merits, even though they are directed to independent and distinct inventions." Therefore, Applicants respectfully request that the Examiner withdraw the requirement for election of a single STSRP protein and nucleic acid pair.

Furthermore, the search of all five STSRPs would not be unduly burdensome according to the November 19, 1996 statement by the Commissioner that a reasonable number of sequences may be claimed in a single application (See Examination of Patent Applications Containing Nucleotide Sequences, 1192 O.G. 68 (November 19, 1996)). In this case there are five nucleic acid sequences in Groups A, B, C, D, and E, and all relate to signal transduction stress related proteins. According to the MPEP Section 803.04, ten sequences are considered a reasonable number for examination.

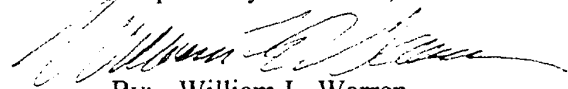
In the alternative, Applicants would elect with traverse Claims 1-11 and 15-23 (Claim Group I), and would further elect with traverse the PLC-2 protein and nucleic acid pair

Response to Restriction Requirement
U.S. Serial No. 09/828,447
Page 3 of 3

(Invention B-SEQ ID NOS:12 and 7). The election is respectfully traversed on the basis that that examination of claims relating to PLC-1 and PLC-2 (SEQ ID NOS:11 and 6, 12 and 7, respectively) would not be an undue burden because of their close technological relationship. For the foregoing reasons, Applicants elect with traverse Claims 1-11 and 15-23 (Claim Group I) and further elect with traverse the PLC-2 protein and nucleic acid pair (Invention B-SEQ ID NOS:12 and 7).

The foregoing is submitted as a full and complete response to the Office Communication mailed April 30, 2002. If there are any issues which can be resolved by telephone conference or an Examiner's Amendment, the Examiner is invited to call the undersigned attorney at (404)853-8081.

Respectfully submitted,



By: William L. Warren
Reg. No. 36,714

SUTHERLAND ASBILL & BRENNAN LLP
999 Peachtree Street
Atlanta, Georgia 30309
(404) 853-8000 / (404) 853-8081 (direct)
SAB Docket 16313.0037